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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,536	04/09/2001	Shelton Louie	1205-007/JRD	8460
21034	7590	12/28/2005	EXAMINER	
IPSOLON LLP			ZEENDER, FLORIAN M	
805 SW BROADWAY, #2740			ART UNIT	
PORTLAND, OR 97205			PAPER NUMBER	

3627

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/829,536

Applicant(s)

LOUIE ET AL.

Examiner

F. Ryan Zeender

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 8-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

The disclosure is objected to because of the following informalities: On page 4, lines 12-14, the language is grammatically incorrect. On page 6, line 21, it appears the language, "customer pickup or filing" should be changed to –customer pickup or filling--. On page 7, line 8, the language, "within throughout" is confusing and it appears the terminology should be changed to –throughout--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6 and 8-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 1, the combination of the following steps: (1) grouping said plurality of prescription orders together in a common carrier, (2) automatically and electronically bundling said plurality of prescription orders from the customer together so as to allow them to be identified with the customer, and (3) automatically detecting the prescription

orders at the at least one location by sensing the at least one identifying tag attached to the common carrier; are not supported by the original specification.

In claim 5, the combination of the following elements: (1) means for grouping the plurality of prescription orders into a common carrier, (2) means for automatically and electronically bundling the plurality of prescription orders from a customer together so as to allow them to be identified with the customer, and (3) said first tag reader able to automatically detect the presence of said tag.

***Claim Rejections - 35 USC 103***

Claims 1-6 and 8-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denenberg in view of Mccullough et al., Markman and Engellenner et al.

Denenberg et al disclose a method for tracking prescription orders through a retail pharmacy having a plurality of spaced apart locations comprising the steps of receiving the prescription order at a first location (col. 9, lines 64 through col. 10, line 4); entering data into a computer system at a second location (16); tagging a carrier of the prescription order with a barcode (col. 6, lines 30-38); storing the filled prescription at one of a plurality of storage locations having a plurality of cubbies (14, 18, 20); automatically detecting the prescription order at one of the plurality of storage locations with a barcode reader (col. 8, lines 46-50); recording the location of the prescription order (col. 6, lines 39-47); displaying the location on a computer display that is viewable by pharmacy workers (col. 13, lines 27-47); automatically collecting timing information, storing the timing information, compiling workflow information based on the

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timing information, and determining an estimated completion time (col. 16, lines 1-43); grouping a plurality of prescription orders together in a common carrier (i.e., See for example the bag Fig. 5B; and Col. 10, lines 54-67).

Denenberg does not teach that prescription orders are tagged with a tag having the same identifier, wherein the identifier is unique to the customer nor does Denenberg teach the step of displaying status of prescription orders on a customer display.

Mccullough et al teach a paging system, wherein a unique customer identifier is used to identify prescriptions (col. 6, lines 6-52). Mccullough et al further teach a customer display (108) that displays the unique customer code and notifies the customer of the order status (see col. 3, lines 31-38; and col. 6, line 53 through col. 7, line 25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Mccullough et al with the invention of Denenberg to help a customer retrieve his prescription as quickly as possible.

Denenberg does not teach the step of automatically and electronically bundling the orders from the customer together so as to allow them to be identified with the customer and **tagging the common carrier**. Markman teaches a method and apparatus for reforming grouped items that comprises the step of automatically and electronically bundling orders from a customer together to allow them to be identified with the customer (see, for example, col. 2, lines 52-67 and col. 6, line 65 through col. 7, line 8), **and further tagging a common carrier (i.e., "label"; the common carrier would be the bundled together clothes hanger(s) common at dry cleaners; See col. 7, lines 9-21)**. It would have been obvious to one of ordinary skill in the art at the

time the invention was made to employ the teachings of Markman with the invention of Denenberg to automatically and electronically bundle a customer's orders and **tag a common carrier** to allow them to be identified with the customer for customer convenience.

Denenberg et al does not teach automatically detecting the identifying tag. Engellenner discloses an electromagnetic tag and tag reader (see Fig. 1) for locating items. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the tag and tag reader of Engellenner in Denenberg et al, because the tag reader of Engellenner can interrogate a larger spatial region.

Denenberg et al fail to teach a tag that is detachably secure to the prescription order (**common carrier**) or that is rigidly secured to the prescription order (**common carrier**). However, detachable and rigidly secure tags are both common in the art, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a rigidly secured tag with the invention of Denenberg et al to ensure that the tags aren't mistakenly lost. Alternatively, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a detachable tag with the invention of Denenberg et al, so that the tags may be re-used.

Denenberg et al. also fail to disclose a tag reader for each cubby. However, Denenberg et al disclose a tag reader (50) for the entire station, and an additional sensor (23) for each cubby that detects when a prescription is placed in the cubby or moved away. It would have been obvious to one of ordinary skill in the art at the time

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the invention was made to employ a tag reader in each cubby, to reduce the workload of the worker and reduce error.

Denenberg does not teach that the cubby tag readers are hand-held and manually operated. However, hand-held and manually operated tag readers are common in the art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ hand-held and manually operated tag readers so that employees can be sure that the tags have been properly read.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Denenberg et al., Mccullough et al, Markman, and Engellenner et al as applied to claim 19 above, and further in view of Yehuda. Denenberg et al., Mccullough et al, Markman, and Engellenner et al teach all of the limitation of the claim except for a display of estimated completion. Yehuda discloses a display (16) that shows an estimated time until completion (see col. 4, lines 44-64). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Yehuda with the combination of Denenberg et al., Mccullough et al, Markman, and Engellenner et al. to help the customer quickly complete his transaction.

### ***Response to Arguments***

Applicant's arguments filed 10/11/2005 have been fully considered but they are not persuasive, especially in light of the new ground of rejection. The applicant states on page 1 of his "REMARKS" that Denenberg teaches away from automatic tracking of prescription orders. The Examiner reminds applicant that "automatic tracking" is not

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specifically claimed. "Automatically detecting" is claimed and this limitation is well known in the art, as taught by Engellenner, and a modification of Denenberg to include an electromagnetic tag instead of a bar code type tag, would have been within in the level of ordinary skill.

The applicant further argues that there is no teaching to group the plurality of prescription orders together in a common carrier and to electronically bundle a plurality of prescription orders from the same customer together using the common carrier. Again, the applicant has argued limitations that are not specifically claimed. Nowhere does applicant specifically claim electronically bundling using the common carrier. The applicant has further stated that the pending claims include limitations that the prescription orders are "electronically associated with each other". However, this is not specifically claimed either. The applicant further mentions that his invention "tracks the common carrier through the pharmacy". However, the claims only specifically state automatically detecting the prescription orders at the at least one location (which may include a single location) by sensing the tag attached to the common carrier. It is believed that the rejection above using Markman is proper in view of the claim language as presently written.

The applicant further argues (numeral "3" on page 7) that the Examiner has not cited any reference to teach certain limitations. However, the applicant has not properly requested that the Examiner provide additional references for specific claim limitations and the Examiner maintains that certain limitations would have been obvious to one of ordinary skill. Thus, the rejections have been maintained.



The applicant further mentions that McCullough et al. do not teach use within a pharmacy. However, in Column 6, McCullough does disclose such use.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. Ryan Zeender whose telephone number is (571) 272-6790. The examiner can normally be reached on Monday-Friday, 8am-5pm.

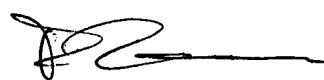
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone

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number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

F. Zeender  
Primary Examiner, A.U. 3627  
December 24, 2005

 12/24/05

**F. RYAN ZEENDER**  
**PRIMARY EXAMINER**